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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,525	03/31/2004	Tushar Kanti Chakraborty	KUMA.P0111US	6907
7590	10/05/2007		EXAMINER	
Joseph J. Crimaldi Renner, Otto, Boisselle & Sklar, LLP Nineteenth Floor 1621 Euclid Avenue Cleveland, OH 44115-2191			SOLOLA, TAOFIQ A	
			ART UNIT	PAPER NUMBER
			1625	
			MAIL DATE	DELIVERY MODE
			10/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/814,525	CHAKRABORTY ET AL.	
	Examiner	Art Unit	
	Taofiq A. Solola	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 31-47 is/are withdrawn from consideration.
- 5) Claim(s) 48 and 49 is/are allowed.
- 6) Claim(s) 1-3,6,7,10,11,14,15,26-28 and 30 is/are rejected.
- 7) Claim(s) 4,5,8,9,12,13,16-25 and 29 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1625

Claims 1-47 are pending in this application.

Claims 1-30 (in part), are drawn to non-elected subject matter.

Claims 31-47 are withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 26-28, 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 26-28 are duplicates of 3, 11 and 19 respectively. The claims are drawn to the same compounds and 26-28 recite properties of the compounds. Such are inherent in the compounds of 3, 11 and 19. Something old or obvious does not become new upon discovery of new properties, functions or utilities. *In re Best*, 562 F.2d 1252; 195 USPQ 430 (CCPA, 1977).

By deleting the duplicates the rejection would be overcome.

Claim 30 is confusing. The claim recites "ration" in line 3. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Art Unit: 1625

Claims 1-3, 6-7, 10-11, 14-15, 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prassad et al., US 2005032707.

Claims 1-2, 6, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chakraborty et al., Tetrahed. Lett., (2002), Vol 43(7), pages 1317-1320.

Claims 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wells et al., WO 9411398; Hodohara et al., Nippon Kessen Shiketsu Gakkaishi (1992), Vol 3(3), pages 163-8; individually.

Applicant claims compounds of formula 1, wherein R is selected from H, Boc, amine and others; R1 is OH, -O-alkyl, amine, or others and R2 is alkyl.

Determination of the scope and content of the prior art (MPEP 32141.01)

Prassad et al., et al., teach compounds of formula 1, compounds of formula 1, wherein R is selected from H or Boc; R1 is OH or -O-alkyl and R2 is H. See the marked compounds on the attached abstract.

Chakraborty et al., teach compounds of formula 1, wherein R is selected from H or Boc; R1 is -O-alkyl and R2 is H. See the marked compounds on the attached abstract.

Wells et al., teach compounds of formula 1, wherein R is selected from H, Boc, amine or others; R1 is OH, -O-alkyl, amine, or others and R2 is H. See the marked compounds on the attached abstract.

Hodohara et al., teach compounds of formula 1, wherein R is H; R1 is amine or others and R2 is H. See the marked compounds on the attached abstract.

Ascertainment of the difference between the prior art and the claims (MPEP 32141.02)

The difference between the instant invention and that of the prior art is that applicant claims alkyl at position R2 while the prior arts teach H at the position.

Finding of prima facie obviousness--rational and motivation (MPEP 32142.2413)

However, H and alkyl are art recognized equivalents. *In re Lincoln*, 53 USPQ 40 (CCPA, 1942); *In re Druey*, 319 F.2d 237, 138 USPQ 39 (CCPA, 1963); *In re Lohr*, 317 F.2d 388, 137 USPQ 548 (CCPA, 1963); *In re Hoehsema*, 399 F.2d 269, 158 USPQ 598 (CCPA, 1968); *In re Wood*, 582 F.2d 638, 199 USPQ 137 (CCPA, 1978); *In re Hoke*, 560 F.2d 436, 195 USPQ 148 (CCPA, 1977); *Ex parte Fauque*, 121 USPQ 425 (POBA, 1954); *Ex parte Henkel*, 130 USPQ 474, (POBA, 1960).

Therefore, the instant invention is *prima facie* obvious from the teachings of the prior arts. One of ordinary skill in the art would have known to replace H with alkyl at the time the instant invention was made. The motivation is from the knowing that H and alkyl are equivalents.

Response to Argument

Applicant's arguments filed 8/31/07 have been fully considered but they are not persuasive. Applicant argues that each prior art, as a whole, does not provide motivation or suggestion for structural modifications made by applicant. This argument is foreclosed by the recent decision in *KSR Int. Co. v. Teleflex Inc.*, 127 S.Ct. at 1741, 82 USPQ2d 1385 at 1396 (2007). Applicant further argues that the compounds of the prior arts are for utilities different from the instant compounds. This is not persuasive for reason set forth above. See *In re Best*, supra.

Objection

Claims 4-5, 8-9, 12-13, 16-25 are objected to for depending from subsequent claims. Under the US patent practice a claim must depend from a precedent claim. Claim 1 is objected to for containing non-elected invention.

Allowable Subject Matter

Claims 48-49 are allowed over prior arts of record, while 29 is object to for depending from a rejected claim.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD, JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.



Maofiq Solola
PRIMARY EXAMINER
Group 1625

September 29, 2007